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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/561,418

12/19/2005

Joseph McCrossan

92478-8500

6542

52044

7590

10/14/2009

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EXAMINER

HASAN, SYED Y

ART UNIT

PAPER NUMBER

2621

MAIL DATE

DELIVERY MODE

10/14/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/561,418	Applicant(s) MCCROSSAN ET AL.	
	Examiner SYED Y. HASAN	Art Unit 2621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 April 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 38 - 46 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 38 - 46 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>12/19/2005, 3/15/2007, 8/31/2007, 10/16/2007,</u> | 6) <input type="checkbox"/> Other: _____ |
| <u>12/06/2007, 1/30/2008 and 7/29/2009.</u> | |

DETAILED ACTION

Claim Objections

1. Claims 40 - 42 are objected to because of the following informality:

(1) Claims 40 – 42 are missing from the latest submission on 4/23/2009. Revised claims were obtained in a fax from Sharon Farnus on 09/14/2009. These revised claims are attached with this submission.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent thereof, subject to the conditions and requirements of this title.

The USPTO “Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility “(Official Gazette notice of 22 November 2005), Annex IV reads as follows:

Claims that recite nothing but the physical characteristics of a form of energy, such as a frequency, voltage, or the strength of a magnetic field, define energy or magnetism, per se, and as such are nonstatutory natural phenomena. O'Reilly, 56 U.S. (15 How.) at 112-14. Moreover, it does not appear that a claim reciting a signal encoded with functional descriptive material falls within any of the categories of patentable subject matter set forth in Sec. 101.

... a signal does not fall within one of the four statutory classes of Sec. 101

... signal claims are ineligible for patent protection because they do not fall within any of the four statutory classes of Sec. 101.

Claim 45 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter as follows.

Claim 45 defines a “program” with descriptive material.

A “program” embodying functional descriptive material is neither a process nor a product (i. e. a tangible “thing”) and therefore does not fall into one of the four statutory class of 101. Rather a “program” is a form of energy, in the absence of any physical structure or a tangible material.

Because the full scope of the claim as properly read in light of the disclosure encompasses non- statutory subject matter, the claim as a whole is non-statutory. The examiner suggests amending the claim to include the disclosed tangible readable computer readable media, while at the same time excluding the intangible media such as software, signals, carrier waves, etc. Any amendment to the claim should be commensurate with its corresponding disclosure.

3. Claims 41 and 44 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 41 and 44 are rejected under 35 U.S.C. 101 as not falling within one of the four statutory categories of invention. While the claims recite a series of steps or acts to be performed, a statutory “process” under 35 U.S.C. 101 must (1) be tied to another statutory category (such as a particular apparatus), or (2) transform underlying subject matter (such as an article or material) to a different state or thing (“[t]he Supreme Court has recognized only two instances in which such a method may qualify as a section 101 process: when the process ‘either [1] was tied to a particular apparatus or [2] operated to change materials to a ‘different state or thing.’” See PTO Supp. Br. 4 (quoting *Flook*, 437 U.S. at 588 n.9). In *Diehr*, the Supreme Court confirmed that a

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process claim reciting an algorithm could state statutory subject matter if it: (1) is tied to a machine or (2) creates or involves a composition of matter or manufacture. 12 450 U.S. at 184.” *In re Comiskey*, 84 USPQ2d 1670 (Fed. Cir. 2007). The instant claims neither transform underlying subject matter nor positively tie to another statutory category that accomplishes the claimed method steps, and therefore do not qualify as a statutory process. In order for a process to be “tied” to another statutory category, the structure of another statutory category should be positively recited in a step or steps significant to the basic inventive concept, and NOT just in association with statements of intended use or purpose, insignificant pre or post solution activity, or implicitly.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 38 and 41 - 45 are rejected under 35 U.S.C. 102 (b) as being anticipated by Murase et al (US 5907658).

Regarding **claim 38**, Murase et al discloses a reproduction apparatus comprising:

an acquire unit operable to acquire, from a recording medium, a graphics stream including a data packet and a control packet, the data packet including graphics data and a decode time stamp indicating a decoding time of the graphics data (fig 18, col 22,

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lines 56 – 67, the digital stream is made up of audio, video, and sub-picture "SP" data; fig. 19b clearly shows that this a graphics menu giving a user a "yes" or "no" option and fig 21 shows more graphic data) and

the control packet including a presentation time stamp indicating a presentation time of the graphics data (col 12, lines 57 – 67, PTS is the time stamp indicating decoding time)

a processor operable to start a process for decoding the graphics data at the decoding time indicated by the decode time stamp (col 12, lines 45 – 53, DTS is the decoding time stamp)

a controller operable to write the decoded graphics data in a graphics plane by the presentation time indicated by the presentation time stamp, the graphics plane being an area where the graphics data is rendered (fig 19 A and B illustrate the graphics plane and col 33, lines 55 – 61 illustrates writing decoded data utilizing PTS)

Claims 41 and 42 are rejected based on claim 38 above

Claims 43 and 44 are rejected based on claim 38 above with the added limitation of recording on a recording medium disclosed by Murase et al (figs 6A – 6D, col 12, lines 17 - 22)

Claim 45 is rejected based on claim 38 above with the added limitation of a reproduction program disclosed by Murase et al (fig 31, col 35, line 65 to col 36, line 13 illustrates a programming sequence)

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 39 is rejected under 35 U.S.C. 103(a) as being unpatentable over Murase et al (US 5907658) in view of Hayashi (US 6868096) and further in view of Kataoka et al (US 6282209)

Regarding **claim 39**, Murase et al discloses the reproduction apparatus (see claim 38 above)

However Murase et al does not wherein: the data packet further includes another presentation time stamp indicating a time obtained by adding a predetermined value to the decoding time indicated by the decode time stamp, and the processor ends the decoding by the time indicated by said another presentation time stamp included in the data packet.

On the other hand Hayashi teaches the data packet further includes another presentation time stamp indicating a time obtained by adding a predetermined value to the decoding time indicated by the decode time stamp (col 4, lines 18 – 39, illustrates adding predetermined time to decoding time)

It would have been obvious to one of ordinary skill in the art at the time of the

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invention to incorporate the data packet further includes another presentation time stamp indicating a time obtained by adding a predetermined value to the decoding time indicated by the decode time stamp as taught by Hayashi in the system of Murase et al in order to input the system clock signal to a predetermined position of the system header.

The combination of Murase et al and Hayashi do not disclose the processor ends the decoding by the time indicated by said another presentation time stamp included in the data packet.

On the other hand Kataoka et al teaches the processor ends the decoding by the time indicated by said another presentation time stamp included in the data packet (abstract illustrates ending decoding utilizing pts)

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the processor ends the decoding by the time indicated by said another presentation time stamp included in the data packet as taught by Kataoka et al in the combined system of Murase et al and Hayashi in order to accurately download a segment or whole of received continuous program from the data stream.

8. Claims 40 is rejected under 35 U.S.C. 103(a) as being unpatentable over Murase et al (US 5907658) in view of Hayashi (US 6868096) in view of Kataoka et al (US 6282209) and further in view of Chung et al (KR 2002007659 A)

Regarding **claim 40**, Murase et al, Hayashi and Kataoka et al disclose the reproduction apparatus (see claim 38 and 39 above)

However Murase et al, Hayashi and Kataoka et al do not disclose wherein

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the predetermined value is obtained by dividing a size of the graphics data by a decoding rate at which the processor decodes the graphics data.

On the other hand Chung et al teaches wherein the predetermined value is obtained by dividing a size of the graphics data by a decoding rate at which the processor decodes the graphics data (abstract description, illustrates dividing input signal into predetermined data)

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate wherein the predetermined value is obtained by dividing a size of the graphics data by a decoding rate at which the processor decodes the graphics data as taught by Chung et al in the combined system of Murase et al, Hayashi and Kataoka et al in order to improve product reliability.

9. Claim 46 is rejected under 35 U.S.C. 103(a) as being unpatentable over Murase et al (US 5907658) in view of Takemura (JP 06275054 A)

Regarding **claim 46**, Murase et al discloses all the limitations of this claim (see claim 38 above) except for an integrated circuit.

On the other hand Takemura teaches an integrated circuit (basic abstract)

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate an integrated circuit as taught by Takemura in the system of Murase et al in order to conserve space.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure

Ando et al (US 6580869) discloses recording medium of stream data including management information used to access the stream data, and recording method and playback method of the same

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Syed Y. Hasan whose telephone number is 571-270-1082. The examiner can normally be reached on 9/8/5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thai Tran can be reached on 571-272-7382. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/S. Y. H./
09/22/2009

/Thai Tran/
Supervisory Patent Examiner, Art Unit 2621